

REMARKS/ARGUMENTS

In this reply, Claims 1 and 14-26 are amended. Claims 1-26 are pending in the application. The amendments to the claims as indicated herein do not add any new matter to this application.

INTERVIEW SUMMARY

Examiner Michael Pham and Primary Examiner Luke Wassum are thanked for their thoughtful participation in the interview on Wednesday, April 21, with Applicants' Representatives Marcel Bingham and Eric Sutton. During the interview, the parties generally discussed the claimed subject matter and the Fujiwara reference. The examiners agreed that there was no "rational basis" to support the rejection of Claim 1 under 35 U.S.C. § 102. In other words, the rejection of Claim 1 was made without the required legal basis. Applicants respectfully request withdrawal of the rejection of Claim 1. In an effort to efficiently advance this application towards allowance, Applicants present amendments to Claims 1 and 14 that provide additional context for the claimed subject matter.

CLAIM REJECTIONS—35 U.S.C. § 101

Claims 14-26 were rejected under 35 U.S.C. § 101 for allegedly being directed to non-statutory subject matter.

Claims 14-26 now explicitly recite a "non-transitory machine-readable storage medium storing one or more sequences of instructions, which when executed by one or more processors, causes the one or more processors to perform a method." A non-transitory medium qualifies as statutory subject matter under 35 U.S.C. § 101.

A notice of January 26, 2010, from Director David Kappos of The USPTO states:

"The United States Patent and Trademark Office (USPTO) is obliged to give claims their broadest reasonable interpretation consistent with the specification during proceedings before the USPTO. See *In re Zletz*, 893 F.2d 319 (Fed. Cir. 1989) (during patent examination the pending claims must be interpreted as broadly as their terms reasonably allow). The broadest reasonable interpretation of a claim drawn to a computer readable medium (also called machine readable medium and other such variations) typically covers forms of non-transitory tangible media and transitory propagating signals per se in view of the ordinary and customary meaning of computer readable media, particularly when the specification is silent. See MPEP 2111.01. When the broadest reasonable interpretation of a claim covers a signal per se, the claim must be rejected under 35 U.S.C. § 101 as covering non-statutory subject matter. See *In re Nuijten*, 500 F.3d 1346, 1356-57 (Fed. Cir. 2007) (transitory embodiments are not directed to statutory subject matter) and *Interim Examination Instructions for Evaluating Subject Matter Eligibility Under 35 U.S.C. § 101*, Aug. 24, 2009; p. 2.

The USPTO recognizes that applicants may have claims directed to computer readable media that cover signals per se, which the USPTO must reject under 35 U.S.C. § 101 as covering both non-statutory subject matter and statutory subject matter. In an effort to assist the patent community in overcoming a rejection or potential rejection under 35 U.S.C. § 101 in this situation, the USPTO suggests the following approach. A claim drawn to such a computer readable medium that covers both transitory and non-transitory embodiments may be amended to narrow the claim to cover only statutory embodiments to avoid a rejection under 35 U.S.C. § 101 by adding the limitation "non-transitory" to the claim. *Cf. Animals - Patentability*, 1077 *Off. Gaz. Pat. Office* 24 (April 21, 1987) (suggesting that applicants add the limitation "non-human" to a claim covering a multi-cellular organism to avoid a rejection under 35 U.S.C. § 101). Such an amendment would typically not raise the issue of new matter, even when the specification is silent because the broadest reasonable interpretation relies on the ordinary and customary meaning that includes signals per se. The limited situations in which such an amendment could raise issues of new matter occur, for example, when the specification does not support a non-transitory embodiment because a signal per se is the only viable embodiment such that the amended claim is impermissibly broadened beyond the supporting disclosure. See, e.g., *Gentry Gallery, Inc. v. Berkline Corp.*, 134 F.3d 1473 (Fed. Cir. 1998)."

The specification supports several viable embodiments of non-transitory media, such as volatile media and non-volatile media. Accordingly, Applicants respectfully request withdrawal of the rejection under 35 U.S.C. § 101 of Claims 14-26.

CLAIM REJECTIONS—35 U.S.C. § 112, SECOND PARAGRAPH

Claims 1 and 14 were rejected under 35 U.S.C. § 112, second paragraph, as allegedly indefinite. This rejection is respectfully traversed.

Applicants respectfully submit that this rejection was made erroneously. Claims 1 and 14 were rejected (Office Action, pgs. 2-3) for allegedly omitting the “how.” The written description broadly describes the claimed embodiments. Specific embodiments from the specification are not essential to the claimed subject matter, and there is no legal basis for requiring a claim to recite the “how.” With or without these specific embodiments, the claims clearly and distinctly recite what is believed to be new, useful, and non-obvious patentable subject matter.

CLAIM REJECTIONS—35 U.S.C. § 102

Claims 1-26 were rejected under 35 U.S.C. § 102(b) as being allegedly anticipated by U.S. Patent Application Publication No. 2003/0014394 (“Fujiwara”). This rejection is respectfully traversed.

CLAIM 1

Claim 1 recites:

A machine-implemented method for executing a database statement, the method comprising the steps of:
a database server receiving a request to execute the database statement, wherein the request includes the database statement and a tag that does not conform to a database language of said database statement, wherein said tag is not embedded in said database statement;
wherein said tag specifies at least one parameter field and at least one parameter value;
in response to receiving the request, said database server storing information from the tag in a manner that is associated with said database statement and accessible to a tag access mechanism;
said database server executing said database statement, wherein during execution of said database statement said database server provides access to one or more of the at least one parameter value through said tag access mechanism provided by said database server.

Claim 1 involves “a request to execute the database statement” that “includes the database statement and a tag that does not conform to a database language of said database statement, wherein said tag is not embedded in said database statement.” The tag “specifies at least one parameter field and at least one parameter value,” and information from the tag is stored “in a manner that is associated with said database statement and accessible to a tag access mechanism.” Further, the database server executes the database statement and, “during execution of said database statement said database server provides access to one or more of the at least one parameter value through said tag access mechanism provided by said database server.”

The examiners agreed that the rejection of Claim 1 was made without the required legal basis. A discussion of Fujiwara is provided herein to promote an efficient prosecution of this application on the merits of the claims.

Fujiwara does not show a request to execute a database statement that includes the database statement and a tag that does not conform to a database language of said database statement. In Fujiwara, an original query, such as the one shown in FIG. 11, is translated into a translated query such as the one shown in FIG. 13. The original query does not reference a call to a masking function, and the translated query embeds a call to the masking function into the original query. As shown in FIG. 12, DBMS 702 receives and executes the translated query. In Fujiwara, the calls to the masking functions are embedded in the database statement in a manner that conforms to the database language of the database statement. Fujiwara does not show “a request to execute the database statement” that “includes the database statement and a tag that does not conform to a database language of said database statement, wherein said tag is not embedded in said database statement,” as featured in Claim 1.

Additional reasons supporting the patentability of Claim 1 over the art of record may be found in Applicants' previous reply, which was submitted with a Request for Continued Examination.

For at least those reasons provided, Claim 1 is patentable over the art of record. Applicants respectfully request withdrawal of the rejection of Claim 1 under 35 U.S.C. § 102.

CLAIM 14

Claim 14 is directed to a non-transitory machine-readable storage medium storing one or more sequences of instructions, which when executed by one or more processors, causes the one or more processors to perform a method that is the same as the method recited in Claim 1. Thus, Claim 14 is patentable over the art of record for at least those reasons provided with respect to Claim 1. Applicants respectfully request withdrawal of the rejection of Claim 14 under 35 U.S.C. § 102.

DEPENDENT CLAIMS

Claims 2-13 depend from Claim 1 and are patentable over the art of record for at least those reasons provided with respect to Claim 1. Similarly, Claims 15-26 depend from Claim 14 and are patentable over the art of record for at least those reasons provided with respect to Claim 14. In order to efficiently advance this application towards allowance, additional features recited in the dependent claims are not separately addressed at this time. Applicants respectfully request withdrawal of the rejections of Claims 2-13 and 15-26 under 35 U.S.C. § 102.

CONCLUSION

For the reasons set forth above, it is respectfully submitted that all of the pending claims are now in condition for allowance. Therefore, the issuance of a formal Notice of Allowance is believed next in order, and that action is most earnestly solicited.

The Examiner is respectfully requested to contact the undersigned by telephone if it is believed that such contact would further the examination of the present application.

Please charge any shortages or credit any overages to Deposit Account No. 50-1302.

Respectfully submitted,

Hickman Palermo Truong & Becker LLP

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